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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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Applied for Mark	WTC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Trademark Applications of
World Trade Centers Association, Inc.

Serial	85/473,613 (WTC, Cl. 18))	Evin L. Kozak, Esq.
Nos.:	85/473,617 (WTC, Cl. 16))	Trademark Examining Attorney
	85/474,746 (WORLD TRADE CENTER, Cl. 16))	
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	85/527,008 (WORLD TRADE CENTER, Cl. 9))	
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	85/527,100 (WORLD TRADE CENTER, Cl. 14))	
	85/527,119 (WTC, Cl. 14))	

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INTRODUCTION

Applicant World Trade Centers Association, Inc. (“WTCA”) submits this Reply Brief in response to the Examining Attorney’s Appeal Brief (“EA Br.”) regarding eight pending intent-to-use applications for the WORLD TRADE CENTER and WTC marks for various items of Merchandise in Classes 9, 14, 16 and 18.

The Examining Attorney argues that WORLD TRADE CENTER and WTC are incapable of functioning as trademarks for the Merchandise because they are in “common parlance” to refer to the terrorist attacks of 9/11 and are used “in connection with” products sold by third parties to memorialize the attacks. Virtually all of the third-party products shown in the website print-outs relied on by the Examining Attorney bear wording such as “Never Forget,” “Remember” or graphic depictions of the Twin Towers, with the terms World Trade Center or WTC used only descriptively in accompanying material. Expressing concern that registration of Applicant’s marks for the Merchandise might impair public discourse about 9/11 or the sale of commemorative items by third parties, the Examining Attorney has strained to find a statutory basis for refusing registration of the WORLD TRADE CENTER and WTC marks for the Merchandise.

As set forth below and in Applicant’s Supplemental Appeal Brief (“App. Supp. Br.”), the Examining Attorney’s flawed determination that WORLD TRADE CENTER and WTC are incapable of functioning as trademarks is based on inapposite decisions concerning the registrability of common expressions and slogans. At the same time, the Examining Attorney disregards established Board precedent confirming that a designation can perform more than one function and be eligible for registration, so long as one of the functions is to identify the source of products. The WORLD TRADE CENTER and WTC marks satisfy this standard. Further, registration will not detract from the ability of the public to continue using the terms “World

Trade Center” and WTC in their non-trademark sense to refer to the location of the 9/11 terrorist attacks or to provide the context for products commemorating the lives lost that day.

The WORLD TRADE CENTER and WTC marks are registrable for the Merchandise on the additional basis that the marks have acquired distinctiveness through their longstanding prior use and incontestable registrations for association services to promote international trade and business relationships. The USPTO has frequently registered marks for association and building services as well as collateral merchandising items that promote the services, and many Board decisions recognize the common marketing practice of selling such collateral products. Consistent with this practice and precedent, Applicant’s evidence demonstrates that the distinctiveness of the WORLD TRADE CENTER and WTC marks for its services relates, and will transfer to, the intended use of the marks on the Merchandise.

Accordingly, there is no proper legal basis for refusing registration of the WORLD TRADE CENTER and WTC marks for the Merchandise.

A. WORLD TRADE CENTER and WTC Are Capable of Functioning as Trademarks

1. Dual Significance of the WORLD TRADE CENTER and WTC Marks

WTCA contends in its Supplemental Appeal Brief that WORLD TRADE CENTER and WTC are capable of functioning as trademarks because they have a dual significance. One is to perform a trademark, source-identifying function for the Merchandise, and the other is to refer to World Trade Center building facilities and services including, but not limited to, the complex in New York City that was attacked on 9/11. (App. Supp. Br. at 5-6). The Board has affirmed that designations that have a dual function are registrable as trademarks, so long as one of the two functions is to identify the source of goods or services. Thus, whether the non-trademark function of a mark is to indicate the names of television show characters in *In re Paramount*, an international exposition in *In re Expo ‘74*, the “O” ornamental design in *In re Olin Corp.*, or the

historic Monticello home in *In re Thomas Jefferson Foundation, Inc.*, so long as the designation “also serves a source indicating function, it should be regarded as acceptable subject matter for registration.” *In re Paramount*, 213 USPQ 1111, 1113 (TTAB 1982) (emphasis added) (*See App. Supp. Br.* at 4-6).¹

The Examining Attorney misconceives Applicant’s position as an argument that WORLD TRADE CENTER and WTC cannot be refused registration unless they “only” signify the terrorist attacks. (EA Br. at 13)². That is not the case. It is the Examining Attorney who has contended, against the weight of the evidence and the appropriate legal standard, that WORLD TRADE CENTER and WTC are not registrable because they “only” signify the tragic events of September 11. (2/10/12 OA at 2). Applicant asserts that the two marks have a dual significance, one of which is to identify the source of the Merchandise in the Applications.

The Examining Attorney further argues that WORLD TRADE CENTER and WTC fail to function as trademarks because they are in “common parlance” in association with the terrorist attacks of 9/11 (EA Br. at 6 and 13) and should be treated the same as the “commonly used” phrases and slogans found to be unregistrable in *In re Eagle Crest*, 96 USPQ2d 1227 (TTAB 2010); *In re Volvo*, 46 USPQ2d 1455 (TTAB 1998); *In re Manco*, 24 USPQ2d 1938 (TTAB 1992) and *In re Remington Products Inc.*, 3 USPQ2d 1714 (TTAB 1987). These cases are entirely distinguishable because the applied-for marks at issue, respectively -- ONCE A

¹ WTCA disagrees with the Examining Attorney’s contention that *In re Paramount* is “inapposite” because the case involved “ornamentation” and the placement of a mark on a specimen, whereas the present case does not. (EA Br. at 13-14). The Examining Attorney in *Paramount* had argued that “the function” of the MORK & MINDY names on the decals at issue was to identify familiar television characters and thus the names did not function as a trademark. The Board held, however, that the principle enunciated in *In re Olin* with regard to a stylized “O” design on t-shirts applied as well to the word mark MORK & MINDY. Because both the O design and the MORK & MINDY names had dual significance, one of which was to function as trademark for merchandise, the marks were registrable in both cases. The same principle applies here to the designations WORLD TRADE CENTER and WTC.

² The pages in Examining Attorney’s Appeal Brief are not numbered, but for ease of reference, Applicant will refer to page numbers starting with page 1 on the page with the caption in the brief available on TTAVBUE.

MARINE ALWAYS A MARINE, DRIVE SAFELY, THINK GREEN and PROUDLY MADE IN USA -- all had a prior, long-standing existence as common expressions or informational advertising slogans that could not transcend this prior use to become trademarks for products or services. In contrast, WORLD TRADE CENTER and WTC are not long-standing common expressions or slogans. These two designations began their existence as protectable, now incontestably-registered trademarks for association services, and their trademark significance can be extended to the Merchandise identified in the Applications.

To the extent that WORLD TRADE CENTER and WTC are “commonly used” or are in “common parlance” to refer to the terrorist attacks, such as in the news media or in historical narratives and encyclopedia entries, they are not being used as common expressions or informational advertising slogans. Rather, as set forth above, “World Trade Center” and “WTC” are being used in these contexts in a non-trademark manner to identify the buildings that were destroyed on 9/11. This type of use in no way precludes their functioning as trademarks to identify association services or the Merchandise in the Applications. The same is true of the registered trademarks NYPD and FDNY, which are also regularly referred to in association with the 9/11 terrorist attacks, or BOSTON MARATHON, which is referred to in connection with the bombing at the 2013 race. All of these marks are fully capable of functioning as trademarks for merchandising products – and indeed are so registered in the USPTO – the same as WORLD TRADE CENTER and WTC. (3/14/14 Req. Rem., Joachimsthaler Report at ¶¶27-28, 67).

2. Non-Trademark Use on Third-Party Products Does Not Undermine the Trademark Function of the WORLD TRADE CENTER and WTC Marks

Without citation of legal authority or supporting evidence of marketplace impact or consumer perception, the Examining Attorney presumes that consumers will not recognize WORLD TRADE CENTER and WTC as trademarks for the Merchandise that Applicant intends

to sell under the marks because consumers are accustomed to seeing these terms used “in connection with” commemorative products similar in type to the applied-for goods. (EA Br. at 13). As the basis for this assumption, the Examining Attorney has put forth a variety of website printouts of third-party goods, many of which feature photos or drawings of the twin towers and/or the slogans “September 11—Never forget,” “We will never forget,” “9-11-01 Never forget” on the products themselves. (See EA Br. at 7-12). One such example is the tote bag depicted below:

http://www.cowcow.com/twin-towers-911-world-trade-center-new-york-bucket-bag_p21877420
08/07/2013 09:45:20 AM

The screenshot shows the CowCow.com website interface. At the top, there is a navigation bar with links for Home, About Us, FAQ, and Contact Us. A search bar is located on the right, and a shopping cart icon is in the top right corner. The main header features the CowCow.com logo and a promotional banner for a 35% off sale with coupon code XMASJULY13, valid until August 31, 2013. The left sidebar contains a 'SHOP BY CATEGORIES' list and a 'HOT PRODUCTS' section. The main content area displays the 'TWIN TOWERS 911 World Trade Center New York Bucket Bag' for \$32.99. It includes a large image of the bag, a 'VIEW LARGE IMAGE' link, and two smaller images showing the front and back of the bag. The product details section lists features such as being made of leather and nylon, having leather handstraps, and measuring approximately 10.5" (W) x 6.7" (H) x 4.5" (D). A 'Quantity' selector and an 'ADD TO CART' button are also present. Below the product information, there is a 'Reviews for product' section with a 'Join or Login to leave your comment' prompt and a 'Reviews from customers who purchased: Bucket Bag' section showing a 5.00 star rating based on 23 reviews.

(10/15/2013 OA at 30).

The Examining Attorney concedes that what “in connection with” really means is that many of the products are sold “bearing” wording other than Applicant’s marks (EA Br. at 7-12), while the print-outs show that WORLD TRADE CENTER and WTC are only mentioned descriptively in accompanying narrative text. The Examining Attorney further conflates “in connection with” and “bearing” by relying on the facts and decision in *In re Eagle Crest*, 96 USPQ2d 1227 (TTAB 2010). The Board in *In re Eagle Crest* affirmed the Examining Attorney’s refusal to register ONCE A MARINE, ALWAYS A MARINE on the ground that this common expression could not function as a trademark based on website evidence showing widespread third-party use of the applicant’s mark on t-shirts and various other products. This evidence was compared to the applicant’s own specimens of use, showing the mark on the goods in the same manner. The Board concluded that “[b]ecause consumers would be accustomed to seeing this phrase displayed on clothing items from many different sources, they could not view the slogan as a trademark indicating source of the clothing only in applicant.” *Id.* at 1230 (emphasis added).

In re Eagle Crest is therefore distinguishable because the Examining Attorney has failed to put forth sufficient evidence showing widespread third-party use of WORLD TRADE CENTER and WTC on the applied-for goods in a trademark manner that consumers would perceive as an indicator of source. The third-party descriptive uses relied on by the Examining Attorney do not undermine the ability of WORLD TRADE CENTER and WTC to function as trademarks for Applicant’s Merchandise. For example, in *Munters Corp. v. Matsui America Inc.*, 14 USPQ2d 1993 (N.D. Ill. 1989), the court held that the defendant’s non-trademark use of the term “honeycomb” to describe the shape of its products did “nothing to detract from the magnetism” of the plaintiff’s registered HONEYCOMBE mark. *Id.* at 2003. The Examining

Attorney contends that *Munters* is distinguishable because it involved “infringement and descriptive wording.” (EA Br. at 13). However, *Munters* also involved a claim of dilution, where the court was required to consider whether a non-trademark, descriptive use had eroded the source-identifying strength of the plaintiff’s trademark. The court took particular notice of the fact that the defendant did not market its products “under” the name “honeycomb” in determining that the use did not weaken the plaintiff’s HONEYCOMBE mark. 14 USPQ2d at 2003. The same principle applies here, where the Board is being asked whether the non-trademark, descriptive uses compiled by the Examining Attorney, will detract from the ability of WORLD TRADE CENTER and WTC to identify WTCA as the source of the Merchandise.

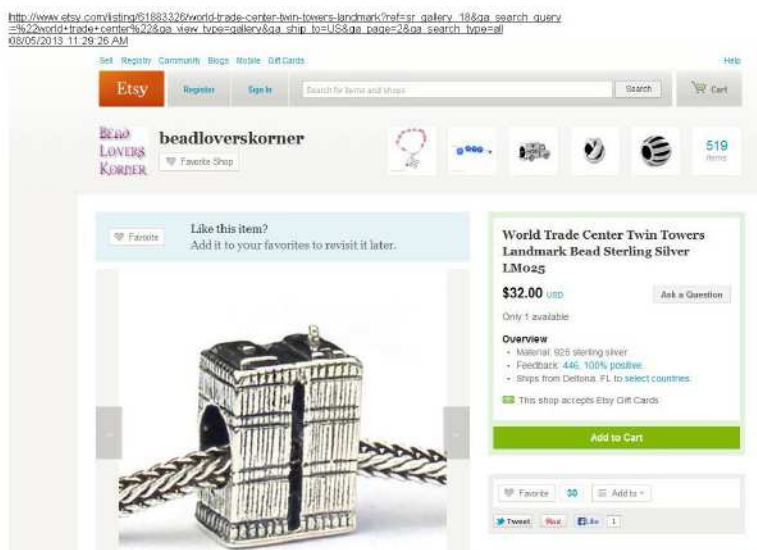
Even assuming *arguendo* that the website printouts of third-party products collected by the Examining Attorney show trademark use of the terms WORLD TRADE CENTER and WTC, they are of limited probative value because the Examining Attorney has “not furnished any evidence regarding the extent of use of the marks by these third parties.” *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125, 1131 (TTAB 1995) (evidence of third-party use is of limited probative value because the pictures tended to indicate that the operations were small and local). Third-party use evidence has repeatedly been found to be unpersuasive where the party proffering such evidence did not demonstrate any marketplace impact of the third-party use on the strength or ability of a mark to indicate the source of goods. *See, e.g., Lovely Skin, Inc. v. Ishtar Skin Care Products, LLC*, 110 USPQ2d 1071, 1067-77 (8th Cir. 2014) (“evidence of third-party registrations was insufficient to weaken a trademark’s acquired distinctiveness where ‘[d]efendant introduced no evidence that these trademarks were actually used by third parties, that they were well promoted or that they were recognized by

consumers’”) (quoting *Scarves by Vera, Inc. v. Todo Imports Ltd.*, 192 USPQ 289 (2d Cir. 1976)).

While the Examining Attorney’s website printouts show that these goods are listed for sale on certain websites, there is often no evidence regarding the quantity of goods sold by these third parties. In some instances, it appears that only a handful of items were sold and/or are offered for sale:



(10/15/2013 OA at 63). For example, the above screenshot from eBay.com shows that only five of these pins were sold, and that only an additional six are available for sale. The following screen shot from Etsy.com shows “Only 1 [jewelry bead] available” for sale:



(10/15/2013 OA at 72). This evidence does not constitute “widespread” third-party use or any material commercial impact in the marketplace on the source-identifying capacity of the WORLD TRADE CENTER and WTC marks. In addition, while some of the printouts are from popular websites, such as Amazon.com, eBay.com and Etsy.com, which also feature thousands, if not millions of other goods, many of the printouts are from websites that appear to be relatively obscure, such as cowcow.com and piecesofhistory.com. All of these factors severely limit the probative value of the Examining Attorney’s evidence. *See Carl Karcher Enterprises Inc.*, 35 USPQ2d at 1131.

3. Applicant’s Evidence, Including the Mantis Survey, Demonstrates that WORLD TRADE CENTER and WTC Can Function as Trademarks for the Merchandise

In contrast to the lack of evidence of the marketplace impact of the third-party products shown in the Examining Attorney’s website printouts, the Mantis Survey provides marketplac evidentiary support for Applicant’s position that WORLD TRADE CENTER can, and will, function as a trademark for representative goods in Class 18, namely, backpacks, fanny packs and tote bags. (3/14/14 Req. Rem., Mantis Report; App. Supp. Br. at 7-13). This type of consumer perception evidence should be viewed as more persuasive on the issue of the ability of WORLD TRADE CENTER to function as a trademark than the website picture of the tote bag shown above in Section A2, which does not even bear the words WORLD TRADE CENTER on the product. Notably, the Examining Attorney does not challenge Applicant’s use of the Mantis Survey to demonstrate that WORLD TRADE CENTER and WTC are capable of functioning as trademarks, presenting her critique of the survey only in the context of Applicant’s argument that its marks have acquired distinctiveness. (EA Br. at 16-19).

While the Examining Attorney criticizes the design of the Mantis Survey and his interpretation of the survey results, no alternative survey design is offered, and many of the

objections raised are without foundation. For example, the Examining Attorney states that it is unclear whether the survey participants are “United States consumers,” and suggests that the results are therefore of limited probative value because the Board is “only concerned with the perception of consumers in the United States.”³ (EA Br. at 18, n. 178 (quoting *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1230 (TTAB 2010)). A review of the survey screener, however, shows that all survey participants were required to answer affirmatively that they resided in the United States. (3/14/14 Req. Rem., Mantis Report, Exhibit A at S1. (“In what state do you live? {Choose One State from The Drop-Down Box Below} **Outside U.S. — TERMINATE.**”)) (emphasis in original))

In a further challenge to the Mantis Survey, the Examining Attorney suggests that relevant data has been withheld from the survey report, including data that supposedly exists for goods in Classes 9, 14 and 16. (EA Br. at 18). Again, a review of the survey screener belies this assertion. The Mantis Survey was designed to assess the capability of WORLD TRADE CENTER to function as a trademark for backpacks, fanny packs and tote bags in Class 18. (3/14/14 Req. Rem., Mantis Report, Exhibit A at I). Accordingly, in order to be eligible to participate in the survey, individuals had to respond affirmatively to screening questions that they had either purchased, or were likely to purchase, one of these three products in the past three months or next three months. All other potential participants were terminated from the survey. (*Id.* at Exhibit A, S5-S6). As such, there was no other data for Mr. Mantis to present regarding individuals who said they were prior or potential purchasers only of the listed goods in Classes 9, 14 and/or 16.

³ Ironically, in support of the position that United States consumers will not view WORLD TRADE CENTER and WTC as source identifiers, the Examining Attorney has submitted website printouts from the Canadian ecommerce website <cafeexpress.ca>. (10/15/13 OA at 23-25). Applicant assumes this was an oversight on her part, but the evidence should nevertheless be excluded.

The entire screener and questionnaire is attached to the Mantis Report and all verbatim responses for any respondent who answered the open-ended survey questions are included in Table 2.⁴ Applicant submits that the results of the Mantis Survey are transparent, and that the Examining Attorney's concern that important data has been withheld is unfounded.

The Examining Attorney's critique of the overall survey design is also without merit. As explained in Applicant's Supplemental Appeal Brief, there is no generally accepted survey design to test whether a designation is capable of functioning as a trademark. (App. Supp. Br. at 8). Accordingly, Mantis, a survey expert with more than forty years of experience, whose surveys have been accepted by the Board and federal courts in numerous cases,⁵ adapted the

⁴ As indicated in the Mantis Report, all qualified participants were first asked a closed-ended question:

Do you associate the name (NAME) when used on backpacks, fanny packs, and tote bags with only one company or organization as the source of these products, more than one company or organization or don't you know or have an opinion.

Participants who answered "one company" were asked two follow-up open-ended questions:

With which company or organization do you associate the name (NAME)?

What if anything, can you tell me about (RESPONSE TO QUESTION 2)?

Participants who answered "more than one company" or don't know/ No opinion in response to the first closed-ended question, were asked a second closed-ended question:

Do you associate the name (NAME) when used on backpacks, fanny packs and tote bags as being authorized or sponsored by only one company or organization more than one company or organization, or don't you know or have an opinion?

Participants who answered "one company" were asked two follow-up open-ended questions:

With which company or organization do you associate the name (NAME) as authorizing or sponsoring these products?

What if anything, can you tell me about (RESPONSE TO QUESTION 5)?

Table 1 in the Mantis Report tabulates the "one company" answers for both of the closed-ended questions. Table 2 includes the verbatim response for all of the open-ended questions. (Note that the numbering of Questions 3, 4, 5 and 6 at the beginning of Table 2 is consistent with the verbatim responses presented in Table 2, but differs from the numbering of the questions as Questions 2, 3, 5 and 6 in the Questionnaire itself).

⁵ See, e.g., *U.S. Polo Ass'n, Inc. v. PRL USA Holdings, Inc.*, 800 F. Supp. 2d 515 (S.D.N.Y. 2011); *Carl Karcher Enterprises Inc.*, 35 USPQ2d at 1131-33.

Teflon survey design that has been accepted to test for both genericness and secondary meaning. (3/14/14 Req. Rem., Mantis Report at 4). Mantis appropriately understood that he was not conducting a *Teflon* survey for genericness, and thus there was no need to include a “primer” about brands or proprietary names vs. common names that is typically presented to respondents at the outset of a *Teflon* survey when genericness is at issue.

What made the survey “*Teflon-style*”, is that Mantis sought to measure the level of single source identification for the WORLD TRADE CENTER mark for the three selected Class 18 goods on a relative basis in comparison to two other brand names that have been registered in the USPTO for similar Class 18 goods – BOSTON MARATHON and LOUISIANA STATE UNIVERSITY – and two common names. This technique of ascertaining a relative measurement of source identification is based on the *Teflon* survey design, in which data about a test name is placed in relative context with the results for other brand and common names with varying levels of trademark significance. *See, e.g., In re Country Music Association, Inc.*, 100 USPQ2d 1824, 1832-33 (TTAB 2011) (applicant conducted a *Teflon* survey for COUNTRY MUSIC ASSOCIATION using NATIONAL RIFLE ASSOCIATION, COKE, JELLO, STP, AMERICAN AIRLINES and ITUNES to assess relative strength of its mark).

Moreover, Mantis specifically tailored the wording of the questions in the survey to evaluate whether WORLD TRADE CENTER is capable of functioning as a trademark for the three Class 18 goods, not whether the mark is generic. Accordingly, participants were asked if they associated the goods with one or more than one entity as the source of the goods or whether the goods were authorized or sponsored by one or more than one entity. While these two closed-ended questions were asked to ascertain the level of single source identification for the five names in the survey, none of the questions used the legal terminology of “single source

identification”, and no explanation of this legal concept was therefore necessary. Indeed, the wording of the closed-ended questions in the Mantis Survey closely tracks the language of questions used in surveys that have been admitted into evidence and relied on to determine the extent of single source identification; in these instances, no educational “primer” has been required before asking a respondent if a product or service bearing a mark comes from “one company or more than one company.” *See, e.g., Farm Fleet Supplies, Inc. v. Blain Supply, Inc.*, Opp. No. 91196469, 2013 WL 449, at *22-25, 47 (TTAB May 2, 2012) (not precedential) (the Board accepted a secondary meaning survey with question wording similar to the Mantis Survey in finding that FARM & FLEET was associated with one company).

Finally, the Examining Attorney expresses disagreement with the way in which Mr. Mantis categorized the answers of two particular individuals, Respondents 64 and 68. However, whether or not these two respondents conceptualize WORLD TRADE CENTER as a “brand”, each had already responded that they associated WORLD TRADE CENTER, when used on backpacks, fanny packs and tote bags, with only one company or organization as the source of the products and that the source was the “World Trade Center” or “The World Trade Center itself.” (3/14/14 Req. Rem., Mantis Report, Exhibit A at 15). Given these prior answers, Mr. Mantis appropriately counted these two individuals among the group of 51 respondents (not 19, as the Examining Attorney suggests) who believed that WORLD TRADE CENTER, when used on backpacks, fanny packs and tote bags, is associated with a single source and that the single source is Applicant WTCA. While the Examining Attorney may disagree with this decision⁶, Mr. Mantis’s determinations were reasonable, consistently applied across the five names tested

⁶ Applicant notes that the Examining Attorney was able to express this difference of opinion because the survey report is transparent and includes all of the open-ended verbatim answers collected by Mantis.

in the survey, and reflect judgments based on his decades of experience in the analysis of survey results.

For all of these reasons, the Board should discount the Examining Attorney's criticisms of the Mantis Survey and accord this consumer perception evidence significant weight in determining that WORLD TRADE CENTER, and its acronym equivalent WTC, are capable of functioning as trademarks for the Merchandise.⁷

**B. Applicant Has Established that the Distinctiveness of the
WORLD TRADE CENTER and WTC Marks for Association
Services is Related and Will Transfer To the Merchandise**

Applicant and the Examining Attorney agree that TMEP § 1212.09(a) permits an intent-to-use applicant to maintain a claim of acquired distinctiveness before filing an allegation of use if the applicant can establish that it has previously used the same mark that has become distinctive for related goods or services, such that the previously-created distinctiveness will transfer to the goods identified in the intent-to-use application. (EA Br. at 14-15). Here, Applicant contends that WORLD TRADE CENTER and WTC, which are the subject of incontestable registrations for association services, are distinctive of such services, and that this distinctiveness is related, and will transfer to, the Merchandise identified in the intent-to-use applications. The Examining Attorney suggests that Applicant is attempting to expand impermissibly the scope of the services enumerated in the two incontestable registrations (EA Br. at 15-16, n. 162), but Applicant is entitled to rely on these registrations as evidence of the

⁷ The Examining Attorney contends that it is "unclear" how the results of the Mantis Survey generalize to the other goods in the Class 18 application for WORLD TRADE CENTER, the WTC mark or the goods in the other application classes at issue on appeal. (EA Br. at 18). Yet the Examining Attorney has offered no consumer perception evidence at all about the use of Applicant's marks on the 104 different products identified in the Applications, whereas Applicant has shown, for at least three products that are typical of the goods in Class 18, that an appreciable number of consumers perceive WORLD TRADE CENTER as a trademark. Since the Examining Attorney bears the burden of proof that WORLD TRADE CENTER and WTC are incapable of functioning as trademarks for the 104 different products, the Examining Attorney should bear the burden of rebutting the inference arising from the Mantis Survey results that WORLD TRADE CENTER and WTC are capable of functioning as a trademark for the remaining products.

distinctiveness of the WORLD TRADE CENTER and WTC marks for association services as a predicate for the claim of acquired distinctiveness for the Merchandise. *See* TMEP § 1212.09(a).

The distinctiveness of the WORLD TRADE CENTER and WTC marks for association services has been amply demonstrated by the decades of continuous use of these marks, evidence of media recognition, receipt of prestigious awards, WTCA's successful licensing program and declarations from its licensees, who explain why they pay for the privilege of using the marks in connection with their international business and trade-related services and facilities. *See* App. Supp. Br. at 18-19. The Examining Attorney concedes that the sworn declarations of Applicant's licensees support the conclusion that the WORLD TRADE CENTER and WTC marks are distinctive for Applicant's association services. (*See* EA Br. at 16, n.163). The expert report of Dr. Erich Joachimsthaler ties together the many activities and initiatives Applicant has undertaken since 1970, all of which have built WORLD TRADE CENTER and WTC into strong and distinctive marks for association services and the promotion of global trade and international business, satisfying the first element of TMEP § 1212.09(a). (3/14/14 Req. Rem., Joachimsthaler Report at ¶¶30-52).

Where Applicant and the Examining Attorney primarily disagree is whether Applicant has sufficiently demonstrated that its association services are related to the Merchandise, such that the distinctiveness of the marks for association services will transfer to the intended use of the marks on the Merchandise. Applicant submits that it has more than met its burden on this issue.

Section 1212.09(a) of the TMEP is very clear that "[t]he showing necessary to establish relatedness will vary from case to case, depending on the nature of the goods or services involved and the language used to identify them." While in some cases the relatedness of

products and services may be self-evident, without any evidentiary showing, extrinsic evidence of the relationship between goods and services may be submitted, including an expert opinion. *See Kellogg Co. v. General Mills Inc.*, 82 USPQ2d 1766, 1171 (TTAB 2007); *see also* TMEP § 1212.04(c) (to show relatedness under Section 2(f) for use-based applications, there may be instances in which products may in fact have a “high degree of relatedness, but it would not be obvious to someone who is not an expert in the field”).

Applicant has provided many examples of third party registrations of marks such as YMCA, BOY SCOUTS OF AMERICA and ROTARY CLUB, which cover both association services and goods of the type identified in the Applications. Other third party registrations for iconic building services and merchandise sold under the same mark, such as ROCKEFELLER CENTER and CHRYSLER BUILDING, establish that a similar relationship will exist between WTCA’s services and the Merchandise identified in the Applications. The Examining Attorney discredits this evidence on the ground that it only establishes that these marks have acquired distinctiveness for the third-party goods. (EA Br. at 15-16). In fact, these third-party registrations constitute evidence of the relationship between association services and merchandising items bearing the association’s primary mark, because they show that consumers have come to expect that merchandising items bearing an association’s mark emanate from the same source as the association’s services.

The Board has repeatedly recognized the principle that goods and services may be related based on consumer expectations that a mark may be licensed and used on collateral merchandise to promote the trademark owner’s core brand name. For example, in *In re Phillips-Van-Heusen Corp.*, 228 USPQ 949 (TTAB 1986), the Board affirmed a refusal to register “21 CLUB” for apparel because the goods were deemed to be related to restaurant services registered under the

same mark by a third-party. As the Board held, “The licensing of commercial trademarks for use on ‘collateral’ products (such as clothing, glassware, linens etc.) which are unrelated in nature to those goods or services on which the marks are normally used, has become a common practice in recent years.” *Id.* at 951; *NASDAQ Stock Market Inc. v. Antartica S.r.l.*, 69 USPQ2d 1718, 1732 (TTAB 2003) (sustaining the opposition to registration of NASDAQ and design for sports equipment and sport clothing based on the opposer’s rights in the same mark for stock market services, finding that “use of trademarks on collateral products has become quite common,” and thus the respective goods and services should be deemed related); *see also Shen Mfg Co. v. Ritz Hotel Limited*, 393 F.3d 1238, 1244 (Fed. Cir. 2005) (“goods that are neither used together nor related to one another in kind may still “be related in the mind of the consuming public as to the origin of the goods.”)

The Joachimsthaler Report provides significant additional evidentiary support for WTCA’s contention that the items of Merchandise identified in the Applications are related to its association services. As Dr. Joachimsthaler indicates, many service institutions, such as NYU and the New York City Fire and Police Departments, sell products similar to the Merchandise bearing their primary service marks so that purchasers can demonstrate their support and affiliation with these institutions. (3/14/14 Req. Rem., Joachimsthaler Report at ¶¶25-29). While the products may be different in kind from the education, fire prevention and public safety services offered under the NYU, FDNY and NYPD marks, they are clearly related to the services offered by the mark owners. As Dr. Joachimsthaler observes, it is the very relationship between the goods and the services that motivates consumers to buy the trademarked goods. (3/14/14 Req. Rem., Joachimsthaler Report at ¶24).

The Board should reject the Examining Attorney's position that Dr. Joachimsthaler's report is of "limited value" because he is an expert retained by Applicant who relied on factual information provided by Applicant. As noted above, TMEP § 1212.04(c) expressly contemplates the submission of expert evidence on the issue of the relatedness of products and services for purposes of proving acquired distinctiveness. Moreover, the TTAB has relied on the testimony of many different types of experts retained by a party to a proceeding who may, in the normal course, rely on factual background information provided by the party in rendering their opinions. *See In re Country Music Association, Inc.*, 100 USPQ2d 1824, 1830-31 (TTAB 2011) (according weight to, and agreeing with, Applicant's expert's second report); *see also In re Carl Walther GmbH*, Serial No. 77096523, 2012 WL 1881492, at *4 (TTAB Oct. 26, 2010) (not precedential) (finding applicant's hand gun expert's declaration "persuasive").

The Mantis Survey provides yet additional extrinsic evidence in the form of consumer perceptions of the relatedness between Applicant's services and the Merchandise. The results of the survey demonstrate that an appreciable number of consumers associated Applicant as the single source of backpacks, fanny packs and tote bags bearing the WORLD TRADE CENTER mark, even though Applicant is not currently using the mark in connection with such goods and is primarily known for its association services and building facilities. This level of association would not occur if the goods and the association services were not perceived as related. *Cf. Bausch & Lomb Inc. v. Leupold & Stevens*, 6 USPQ2d 1475, 1478 (TTAB 1988) (noting the absence of survey evidence that might have established a relationship between applicant's previously sold rifle scopes bearing a gold ring device that was subject to an incontestable registration and the binoculars and spotting scopes that were identified in a subsequent application to register the same gold ring device).

In sum, WTCA has not relied on “mere conjecture” or “theoretical analogy” (*see* EA Br. at 15, 16) concerning the relationship of its association services to the Merchandise. In light of the particular “nature of the goods and services” at issue on this appeal, *see* TMEP § 1212.09(a), Applicant has more than met its evidentiary burden that the Merchandise identified in the Applications are sufficiently related to its association services to warrant the conclusion that the previously-created distinctiveness for the WORLD TRADE CENTER and WTC marks for association services will transfer to the Merchandise.⁸ *Id.*

CONCLUSION

For the foregoing reasons and those set forth in Applicant's prior briefs on appeal, Applicant requests that the refusal of registration be withdrawn and the Applications be passed to publication.

Respectfully submitted,

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⁸ The Examining Attorney argues that “the ultimate test in determining whether a designation has acquired distinctiveness is applicant’s success, rather than its efforts,” quoting TMEP §1212.06(b), which applies to proving the distinctiveness of marks in actual commercial use (EA Br. at 20). However, the WORLD TRADE CENTER and WTC Applications at issue on this appeal were filed based on intent-to-use, and thus Applicant need only demonstrate that the previously-acquired distinctiveness for the marks for association services will transfer to the Merchandise when use in commerce begins. *See* TMEP §1212.09(a).